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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/383,724	08/26/1999	KEUNSUK P. CHANG	361752000100	6966
25227	7590	12/04/2003		
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			EXAMINER TARAZANO, DONALD LAWRENCE	
			ART UNIT 1773	PAPER NUMBER

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/383,724

Applicant(s)

CHANG ET AL.

Examiner

D. Lawrence Tarazano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on September 3, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

The applicants' claims are directed to materials in which the resin of the second resin layer "consists essentially of polypropylene". The examiner interprets "polypropylene" to be materials which predominately contain "propylene" repeating units and would include copolymers and blends of polypropylene resins. The term "polypropylene" is not limited to "polypropylene homopolymers" or a single polypropylene material.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Shah et al. (6,291,063).

Shah et al teach films having a base layer and at least one surface layer. (Claim 25). The base layer comprises polyethylene materials and the surface layer comprises the applicants' claimed combination of components for the expressed purpose of improved processibility (column 2, lines 15-65). The surface layer can be polypropylene materials such as "propylene homopolymer" (column 11, lines 9+), and the amounts of additives such as silicone oil, and fatty

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acid amides are within the claimed range (column 12, lines 30-50). The films are surface treated as claimed (column 13, lines 37+).

The silicone oil can be in the range of **about** 0.1 to 1.0%, the applicants claim a value of 0.08%. A value of 0.8% rounds up to a value of 0.1%, and the term “about” gives the prior art value of 0.1 enough latitude to read on the applicants’ endpoint.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, and 6-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. (5,441,802).

4. Mizuno et al. teach films comprising a substrate layer comprising a crystalline polypropylene and at least one surface layer comprising a polypropylene component and inorganic particles [such as zeolites, (column 3, lines 66+; which correspond to aluminosilicate materials), or non-melting siloxane particles (column 4, lines 5+; which correspond to cross linked silicone particles)]. The surface layers can also comprise silicone oils in amounts of 0.1 to 1 part per resin component A; The thickness of the layers is within the claimed range (column

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6, lines 36+) and the layers may be treated by corona discharge to prevent bleeding of antistatic agents.

5. The essential difference between the claimed invention and the prior art is the specific combination of antiblocking agents and lubricants. In the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the cited antiblocking agents and lubricants in the films taught by Mizuno et al. for their known and expected function, in which the amounts of these components would be directly related to the lubricating / antiblocking properties realized.

6. Regarding claims 6, 7, and 8, the examiner takes the position that the applicants are merely using commercially available additives, which generically fall within the disclosure of Mizuno et al. In the absence of unexpected results related to a specific material used, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used commercially available products for their known and expected function.

7. Claims 1-4, 6-8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah et al. (6,291,063).

8. Shah et al as discussed above teach films having a base layer and at least one surface layer.

9. In the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the cited antiblocking agents and lubricants in the films taught by Shah et al. for their known and expected function, in which the

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amounts of these components would be directly related to the lubricating / antiblocking properties realized.

10. Regarding claims 6, 7, and 8, the examiner takes the position that the applicants are merely using commercially available additives, which generically fall within the disclosure of Shah et al. In the absence of unexpected results related to a specific material used, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used commercially available products for their known and expected function.

***Response to Arguments***

11. Applicant's arguments filed 9/3/2003 have been fully considered but they are not persuasive.

12. Regarding the examiner's interpretation of the claims. The applicants added the phrase "consisting essentially of polypropylene (resin)" by amendment. The specification gives no clear definition of this term. The guidance for this term comes from the general level in the art and the specification.

13. The examiner maintains the position that the term "polypropylene" is a generic term, which included polymers, which are predominately "propylene" monomer. Polypropylene rubber for example is not a polypropylene homopolymer, but a copolymer. A material, which consists essentially of "polypropylene rubber", would merely consist essentially of that material. The same is true for similarly named polyethylene materials (e.g. LLDPE, MDPE), which can be copolymers.

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14. The specification states on page 3, lines 22+: **Materials that may be employed for the biaxially oriented layer are propylene homo-copolymers (sic) or copolymer of propylene and other alpha-olefins having 2-10 carbon atoms.** On the next page of the specification, the applicants describe the additive used in the invention as **various additives known as additives for polypropylene.** The term “polypropylene” appears to refer back to the phrase **propylene homo-copolymers (sic) or copolymer of propylene and other alpha-olefins having 2-10 carbon atoms.** This is consistent with the interpretation set forth by the examiner.

15. The applicants assert that the phrase “consists essentially of polypropylene” is equivalent to the phrase “consists essentially of a polypropylene homopolymer”. Given the breath attributed to the term “polypropylene” in the art and the lack of guidance in the applicants’ own specification, the applicants position is both scientifically flawed and literally unsupported. It is unclear why the applicants didn’t term “homopolymer”, if that is what they really intend.

16. Regarding Shah et al., the applicants state that the prior art siloxane amounts do not fall within the claimed range. The examiner disagrees. The applicants amended the claims to cite an endpoint of 0.08%. The applicants merely carved up the range by using a value from their examples, there is no indication that this is a preferred range or that it has any special properties over a value of 0.1% as claimed before and as taught by the prior art. Values of 0.08% and 0.1% are within scientific error of each other and within numerical rounding.

17. The applicants argue that the polypropylene layer of the prior art is not surface treated and that it is the other layer in the two-layer film that is. Given that the whole film is treated with irradiation, both layers will be affected, including the polypropylene layer. The examiner notes that the applicants do not claim any particular amount of surface treatment only “a surface

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treated by a discharge treatment method that imparts printability to the treated surface”. Almost no treatment is needed to meet this limitation since many types of ink will print on the surface of a plastic film with almost no treatment (e.g. a Sharpie™ pen will print on the surface of an untreated film).

18. In paper 15 (dated March 15), applicants state that Mizuno et al. comprise copolymers and acid modified polypropylene as essential components and that there would be no reason to leave them out in the applicants’ invention. This argument is not persuasive. It is not important if the materials are essential components of the prior art. The issue is how the materials would affect the basic and novel characteristics of their invention. Because the applicants have provided no reason on how the additives would affect their materials, the examiner is not convinced by their arguments.

It has been held that when an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of”, the applicants have the burden of showing that the introduction of additional steps or components would materially change the characteristics of the applicants’ invention. *In re DeLajarte*, 337 F. 2d 870, 143 USPQ 256 (CCPA 1964). In the absence of probative evidence to the contrary, the applicants’ claims are open to the presence of other materials including those taught in the prior art.

Given that the examiner does not support the applicants’ position that the claimed films are “homopolymers” and not copolymers as taught by Mizuno et al. the examiner is not convinced by the applicants’ arguments.

Regarding the limitations of claims 6, 7, and 8, the applicants appear to be using conventional commercially available materials (specification page 4, lines 4+). The applicants



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argue that the examiner's position on this issue is contrary to law (*In re Lee*, 277 F3d 1338, 61 USPQ2d 1430 (Fed. Cir). The examiner notes that the applicants do not cite any sources for their materials nor do they teach how to make these particular additives. If the applicants continue to assert that these are not commercially available additives, then the examiner will take the position that the claims are not enabled.

On page 8 of the applicants' arguments they discuss the heat sealing / slip properties of prior art is different the properties realized in the applicants invention. While this may be the case, there is no nexus between what is claimed and this feature.

### ***Conclusion***

- 1) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (703)-308-2379. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (703)-309-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

D. Lawrence Tarazano  
Primary Examiner  
Art Unit 1773

A handwritten signature in black ink, appearing to be 'DLT' with a large checkmark or flourish at the end.

dlt  
November 17, 2003